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MD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/121,628	07/23/98	SULLIVAN M	SLD-2-035-1-

IM62/0207

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1712	8
DATE MAILED:	02/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 9-121628	Applicant(s) SULLIVAN
	Examiner BUTNER	Group Art Unit 1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 11/4/99.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-8, 12-16 is/are pending in the application.

Of the above claim(s)____ is/are withdrawn from consideration.

☐ Claim(s)____ is/are allowed.

☒ Claim(s) 1-8, 12-16 is/are rejected.

☐ Claim(s)____ is/are objected to.

☐ Claim(s)____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).____

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other____

Office Action Summary

The Newspaper Article, advertisements etc submitted do not completely identify what the Strata ball is made of. Applicant's claims encompass many materials. The claims could not possibly be commensurate in scope with the showing. The outer cover is said to be Balata in the submitted articles/advertisements. The current claims do not call for Balata in the outer cover.

What type of core is used? What metal is used in the ionomer? To what degree neutralized? All these factors contribute to the properties of the ball. The claims are not limited to the commercial strata ball (whatever the commercial ball is actually made of). The articles do not indicate the strata ball is any different than the ball of Nesbitt '193.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8 and 12-16 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 8-815556. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 8-815556. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim 3 layer balls with a high acid ionomer as the inner cover a soft ionomer as the outer cover.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-5, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Nesbitt '193 Patent in view of Horiuchi '739.

Nesbitt discloses golf balls having a hard inner cover and softer outer cover. The inner cover can be Surlyn 1605 and the outer cover can be Surlyn 1855 (col 3 lines 28-40). The amount of acid in the inner cover ionomer is not limited. Surlyn 1605 has 15% acid (see Parnell col 4 line 65) which borders on applicant's acid range. Surlyn 1855 has 10% acid (see Warner col 4 lines 54-56) and a flex modulus of 9000 psi (see Kyo table 4).

It is known that higher acid ionomers are superior in golf balls (see Horiuchi col 1 line 56). It would have been obvious to use a slightly higher acid ionomer in the inner cover of Nesbitt's ball for the expected improvements.

Claims 1-8 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Nesbitt '193 Patent in view of Horiuchi '739 and Sullivan '814.

Nesbitt does not suggest his outer cover as being a blend of hard and soft ionomer.

Blends of hard and soft ionomer are known to provide a balance of distance, spin and durability not obtainable from using a single ionomer (see Sullivan col 3 lines 38-64).

It would have been obvious to use a blend of hard and soft ionomer as Nesbitt's outer cover for the expected benefits.

Applicant's arguments filed 11/4/99 have been fully considered but they are not persuasive. The exhibits relating to commercial success are not declarations/affidavits, do not show the required "nexus" and cannot be considered to be commensurate in scope with the current claims (see MPEP 716.03).

In fact, there is no evidence that the "strata" ball falls within the current claims. Applicant's own arguments attribute the success to the ball because of its hard inner cover and soft outer cover (paper # bottom page 5-top page 6). Nesbitt '193 has the same features.

The examiner no longer has access to 8-815556 to evaluate whether the current claims define the same subject matter as now claimed. Applicant should provide copies of the copending claims to make such an evaluation.

The amendments to claim 1 and 13 merely delete non-ionomer species of outer recover material. Are there dependent claims in the copending application limiting the outer cover to ionomers? If so, double patenting may exist.

Simply inserting "ionomeric" into claim 12 does not change the scope of the claim. The claim required ionomers by virtue of the "salt" language previously.

The obviousness double patenting over 5803831 has been overcome with the terminal disclaimer.

Applicant argues Nesbitt and Horiuchi cannot be combined, because Nesbitt is directed to three layer balls, while Horiuchi is directed to two layer balls.

Of course Horiuchi does not suggest three layer balls. The reference would have been applied anticipatory if such a suggestion was present in the reference.

Arguing the secondary reference is not anticipatory is never convincing against a 103 type rejection.

The examiner relies on Horiuchi to teach the benefits of high acid ionomers. Higher stiffness and higher impact resilience (resulting in better flying performance) is achieved when using ionomers of 16-30% acid. These are precisely the characteristics called for by Nesbitt for his inner layer (col lines 57-60). Nesbitt does not explicitly teach any acid level in his inner cover ionomer (although inherently 15% is used). One practicing Nesbitt's invention would select ionomers of high flex modulus (ie stiffness) and coefficient of restitution (impact resilience). Ionomers of 16-30% acid meet the criteria.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Buttner/mm

DAVID BUTTNER
PRIMARY EXAMINER
GROUP 1500

February 6, 2000